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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,835	06/01/2004	Bruce Albrecht	ITW7510.076	3834
33647	7590	03/10/2005	EXAMINER	
ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (ITW) 14135 NORTH CEDARBURG ROAD MEQUON, WI 53097			SHAW, CLIFFORD C	
		ART UNIT	PAPER NUMBER	
		1725		

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/709,835	ALBRECHT, BRUCE
	<b>Examiner</b>	<b>Art Unit</b>
	Clifford C Shaw	1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_\_.  
2a)  This action is **FINAL**.                    2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-42 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-42 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 01 June 2004 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 0610.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

**Detailed Action**

1.) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.) Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 35 is an apparatus claim, but it depends from method claim 21, making it unclear what the scope of claim 35 is. For the purposes of this Office action, claim 35 will be assumed to depend from claim 22.

3.) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.) Claims 1-11, 14, 15, 22-26, and 32-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al. (5,250,786) taken with the Japanese document no. JP4-356372A. Figures 1 and 2 and the discussion in columns 3-6 disclose a welding type power source with features claimed, including: internal combustion engine associated with element 20; energy storage device at element 10; controller 30 to switch the configuration of the power

supply; auxiliary power provided by element 206; battery charging associated with element 19.

In regard to the functional language in the dependent claims that specifies the timing of switching or changing configurations (e.g., claims 3-8), this language does not impose any structural limitations on the claimed subject matter that would distinguish over Kikuchi et al. (5,250,786). The system of Kikuchi et al. (5,250,786) provides for configuration changes through element 30, and these changes could be effected by this structural element at any arbitrary times, including those claimed. The claims differ from Kikuchi et al. (5,250,786) in calling for a power supply housing. This difference does not patentably distinguish over the prior art. At the time applicant's invention was made, it would have been obvious to have provided the system of Kikuchi et al. (5,250,786) with the housing as claimed, the motivation being the teachings of the Japanese document no. JP4-356372A that it is advantageous to include an engine/generator and battery welding power supply in a housing (see the housing associated with element 57 in figures 3-9 of the Japanese document no. JP4-356372A).

5.) Claims 3-8, 11-13, 16-21, 24-31, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi et al. (5,250,786) taken with the Japanese document no. JP4-356372A as applied to claims 1-11, 14, 15, 22-26, and 32-42 above, and further in view of Paul et al. (5,198,698, cited by applicant). The only aspects of the claims to which the rejection above does not apply are the provisions for various control features dealing with configuration change timings and various sensors associated with controlling the internal combustion engine. These differences do not patentably distinguish over the prior art. At the time applicant's invention was made, it would have been obvious to have controlled the system of Kikuchi et al. (5,250,786) in

the manner claimed, the motivation being the teachings of Paul et al. (5,198,698) that it is advantageous to so control a generator/battery based power supply (see the abstract of Paul et al. (5,198,698)).

6.) The patent to Reynolds et al. (6,777,649), the pre-grant publication to Winkler (2004/0195998) and the Japanese documents no.s JP54-155950A, JP61-135479A, JP4-327375A, JP6-182548A, and JP10-314939A are cited to show prior art welders that include a battery in the welding circuit. The patent to Tiller et al. (6,040,555) is cited to show a prior art welding generator powered by an engine with various feedback signals applied to control the engine.

Any inquiry concerning this communication should be directed to Clifford C Shaw at telephone number 571-272-1182. The examiner can normally be reached on Monday through Friday of the first week of the pay period and on Tuesday through Friday of the second week of the pay period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas G. Dunn, can be reached at 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Clifford C Shaw  
Primary Examiner  
Art Unit 1725

March 4, 2005